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To: Examiner Kyle Stork
Board of Patent Appeals and Interferences
(571) 273-8300

From: Anne Vachon Dougherty
3173 Cedar Road
Yorktown Hts, NY 10598
phone (914) 962-5910
fax: (914) 962-1973

Re; Docket No: JP920000431US1
Serial No: 10/068,425

Comments:
Notice of Appeal and Request for Pre-Appeal Brief Review with remarks attached

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) JP920000431 US1	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] <small>VIA facsimile</small> on <u>December 14, 2005</u></p> <p>Signature <u>Anne Vachon Daugherty</u></p> <p>Typed or printed name <u>Anne Vachon Daugherty</u></p>		Application Number 10/068,425	Filed 02/07/2002
First Named Inventor Fukuda		Art Unit 2178	
Examiner Kyle Stark			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,374</u>.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____.</p>			
<p><u>Anne Vachon Daugherty</u> Signature</p> <p><u>Anne Vachon Daugherty</u> Typed or printed name</p> <p><u>(914)962-5910</u> Telephone number</p> <p><u>Dec. 14, 2005</u> Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

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Claims 1, 3-11, and 13-23 were pending in the application. The Examiner has rejected all of the pending claims under 35 USC 103 as unpatentable over Hori in view of Camut. The Examiner has stated that the claims are rejected as unpatentable over Hori in view of Camut, although all of the claims rejections appear to use Camut as the primary reference and Hori and the secondary reference. Applicants' request for clarification of the rejections was ignored.

The invention is a method, system, article of manufacture, program storage device, and program product for information processing comprising providing an annotation for multiple page files. The method for providing the annotation includes the steps of obtaining a plurality of page files from a web site; generating a group of the page files which have similar page layout structures, providing a first annotation for an arbitrary page file in the group; and correlating the first annotation with at least a part of other page files of the group. The step of generating the group comprises the steps of analyzing the page files to introduce structural descriptive forms for the page layout structures and characteristic values for the structural descriptive forms; using the structural descriptive forms and the characteristic values to calculate an inter-page distance representing a similarity of the page files; and grouping the page files, of which the inter-page distance is equal to or smaller than a predetermined value.

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The Camut patent is directed to testing or validating transcoded content which has been transcoded by a proxy. Camut simulates requests, sends them through the transcoding proxy, and then compares the transcoded results with predetermined expected correct results. As taught at Col. 5, lines 64-66, in Camut, a "request 15 passes through a transcoding proxy 30 and is modified by the transcoding proxy 30 as would be understood by one of skill in the art." Camut does not teach or suggest how the proxy encodes requests. Camut further states, at Col. 6, lines 46-47 that "[e]ach received HTTP response is compared with an expected HTTP response (Block 130, Fig. 2)." However, Camut does not teach or suggest how its system arrives at an "expected HTTP response." Since Camut provides no transcoding details, it cannot be concluded that Camut's transcoding obviates the claimed steps and means set forth in the independent claims.

With specific reference to the language of the independent claims, Camut does not teach or suggest generating a group of page files. The cited passage from Col. 7, lines 18-21 simply states that the testing can be done iteratively, with multiple request results being compared to multiple expected results, in order to validate an entire web site. Camut does not teach or suggest providing an annotation for an arbitrary page and correlating the annotation to part of another page file. The cited passage from Col. 8, lines 33-36 simply state that the Camut invention provides thorough testing of tailoring. Camut

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simply provides no details as to how this tailoring is accomplished. Camut does not teach analyzing page files to introduce structural descriptive forms. The cited passage from Col. 4, lines 5-11 states that a simulated request may include information about a device's display and about the web content that the device is configured to display. Such information in a request does not anticipate or obviate analysis of page files to introduce structural descriptive forms. With regard to the claims step of using the structural descriptive forms and values to calculate an inter-page distance, the Examiner has again cited Col. 8, lines 33-36 and has concluded that the passage teaches "tailoring web content to be displayed on a device of a different size and this content would be the same". The Examiner has erred in both reading and interpreting the passage. With regard to the claimed step of grouping page files having inter-page distance \leq a predetermined value, the Examiner has cited Col. 3, lines 58-61 which states a broad objective of facilitating display, but provides no details about thresholding or grouping.

The Examiner has acknowledged that Camut does not "mention the content in an annotation". Applicants note that the claim language does not include any recitation of the content in an annotation. Moreover, Applicants disagree that the Hori reference provides those teachings which are missing from the Camut patent. The Examiner cites Hori because "Hori mention that annotations are transcoded" (sic). Applicants again note that

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the claim language does not recite transcoding of page files nor of annotations. Rather, the claims recite annotating an arbitrary page file in a group generated in accordance with the recited steps and correlating the annotation with at least part of other page files in the group.

It is well established under U.S. Patent Law that, to establish a *prima facie* case of obviousness, the Examiner must provide references which teach or suggest all of the claim features (*In re Wilson*, 424 F. 2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Moreover, the Federal Circuit has stated that, when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and cannot be resolved "on subjective belief and unknown authority" (*In re Lee*, 277 F. 3d 1338, 1343-1344 (Fed. Cir. 2002)). Since neither Camut nor Hori teaches or suggests the steps and means as claimed, it cannot be maintained that the claims are obvious over the cited art, simply because of the Examiner's beliefs.

Applicants have also argued that, if one were to modify Camut with Hori, one would arrive at a system wherein requests for annotated Web pages would be simulated, the retrieved annotated pages would be transcoded, and the transcoded pages would be compared to expected HTTP responses. Under a Camut/Hori system, no page groups would be generated and any annotation would be done before retrieving pages, not after analyzing

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obtained page files and generating groups therefore. Clearly, one would not arrive at the invention as claimed.

In the **Response to Arguments** section, the Examiner evidences a lack of understanding of the Applicants' arguments in concluding that "the applicant is argued (sic) unclaimed limitations". Applicants were arguing that Camut doesn't teach or suggest the claimed annotating steps, particularly in light of the fact that Camut doesn't even teach any steps for the transcoding that Camut is claiming to test. Further in the **Response to Arguments** section, the Examiner states that it would have been obvious to have combined Camut's use of grouping of page files, citing Col. 8, lines 33-36, with Hori's use of annotations, citing the abstract, "since it would have allowed a user the benefit of adjusting annotations for display on screens of different sizes for easier viewing by a user." As discussed above, the Col. 8 passage does not teach grouping of page files. Moreover, neither reference teaches or suggests adjusting annotations for display. Applicants further note that the present claims do not recite adjusting annotations for display. Accordingly, Applicants believe that the Examiner has erred in rejecting the claims as unpatentable over Hori in view of Camut (or vice versa). Applicants request withdrawal of the final rejection and reopening of prosecution for the application.